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09/855,992	05/15/2001	Charles Eric Hunter	WT-17	9374

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EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/855,992	Applicant(s) Charles Eric, Hunter
Examiner Pierre E. Elisca	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 9/3/2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-13, 15-24, 29-35, 37, 39-57, 59-67, 72-78, 80, 82-96 is/are pending in the application.

4a) Of the above, claim(s) 14, 15-18, 36, 58, 68-71, 79 and 81 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-13, 15-24, 29-35, 37, 39-57, 59-67, 72-78, 80, 82-96 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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**DETAILED ACTION**

***Response to Amendment***

1. This Office action is in response to Applicant's amendment filed on 9/03/2002.
2. Claims 14, 25-28, 36, 58, 68-71, 79, and 81 and claims 90-96 are amended, and therefore, claims 1-13, 15-24, 29-35, 37, 39-57, 59-67, 72-78, 80, 82-96 are pending. *ARE CANCELLED*

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13, 18-24, 29-35, 37, 39-42, 47-57, 59, 61-67, and 72-78, 80, 82-85 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kleiman (U.S. Pat. No. 5,959,945) in view of Yamanaka, Yasuhiro et al. (EP 0975111A2).

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**As per claims 1, 3, 4, 8-13, 15-16, 18-21, 23, 24, 29-31, 37, 39-42, 84, Kleiman**

substantially discloses a method/system for distributing music to local, digital electronic jukeboxes, see., abstract, lines 1 and 2 (which is seen to read on Applicant's claimed invention wherein said a system for distributing music to a plurality of customer households), the system comprising:

a data transmission system for blanket transmitting a plurality of music selections to the plurality of customer households in digital format (see., abstract, lines 5-9, jukebox or customer);

a user station at least one of the customer households, the user station including (see., abstract, lines 9-14, col 4, lines 21-31, col 6, lines 22-40, fig 1, Its);

a user interface for permitting the customer household to preselect a transmitted music selections for recording (see., fig 1, element CM1-n, telephone modem);

a receiver and associated high capacity storage medium for recording (recording or download the music) the preselected music selections in digital form (see., abstract, lines 9-17, col 4, lines 21-31, col 6, lines 22-40; fig 1, Its; preselected music is disclosed by Kleiman in the abstract, lines 9-14, col 4, lines 21-31, col 6, lines 22-40, specifically wherein it is stated that statistics based on compiled by the jukebox representing user demand);

an audio output for outputting audio signals from the high capacity storage medium to a playback device for enabling the customer household to playback the recorded music selections (see., abstract, 5-19, please note that the jukebox of Kleiman can also outputting audio signal and playback the recorded music );

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a central controller system having a database for storing therein information corresponding to each customer household (see., fig 1, abstract, lines 3-19, specifically the central storage location or central controller);

a communications link between the customer households and the central controller system for transmitting, subsequent to the recording, to the user station (see., abstract, lines 5-17, please note that since the central storage location or central controller periodically updates, processes, and schedules individual requests from each jukebox or customer, during which time the jukebox or customer can download or copy the music, and therefore, can transmit or verify subsequently to the recorded to the user when music selection has been recorded or download or copy);

a billing system associated with the central controller system to bill customer households for music selections that are made available for playback (see., col 5, lines 16-28, specifically wherein it is stated that "a secure environment for the transfer of music and other sensitive information for purchasing songs or paying (paying or billing) for services from the central storage location to each of the computer jukeboxes (jukeboxes or customer), please note that the secure environment of Kleiman is capable of billing the customer or jukebox for the music selection). Kleiman also discloses a distributing music to local, electronic jukeboxes via satellite see., abstract, lines 1 and 2, col 7, lines 38-45).

It is noted that Kleiman fails to explicitly disclose that the music selection is in encrypted form to a removable storage medium, such that the music selection can not be decrypted without at least one key. However, Yamanaka, Yasuhiro discloses a TV music broadcasting program that is

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distributed from a distribution through a ground station and a satellite, and a musical-piece program through a plurality of audio channels. A recording medium such as compact disc (CD) or removable storage medium in which the musical-piece is recorded. While recording the musical-piece a key is provided for deciphering at a receiving side for deciphering a musical piece enciphered by scrambling processing and distributed (see., abstract, col 7, lines 26-53, col 11, lines 3-17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the music distribution of Kleiman by including the key enciphering/deciphering taught by Yamanaka, Yasuhiro because such modification would provide the music distribution of Kleiman with the enhanced necessary to download a distributed musical-piece using the proper key.

**As per claims 5, 6, 7, 22, 32-35, 38 and 85 Kleiman** discloses the claimed limitation, wherein the music content transmitted to the central controller system is encoded (see., abstract, lines 19-21, encrypt and decrypt music and monetary certificates).

**As per claims 2, 47-57, 59, 61-67, 72-78, 80, 82-83 Kleiman** discloses the claimed method/system for distributing music to local, electronic jukeboxes via satellite see., abstract, lines 1 and 2, col 7, lines 38-45 (which is seen to read as Applicant's claimed invention wherein it is stated that a system for distributing music to customer households), comprising:

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blanket transmitting a plurality of music selections to the plurality of customer households in digital format (see., abstract, lines 5-9, col 7, lines 10-58, fig 1, Its) transmitting to the customer households with information identifying available music selections that will be transmitted (see., abstract, lines 9-17, col 4, lines 21-31, col 6, lines 22-40, fig 1, Its); preselecting and recording at the customer household a transmitted music selection, the recording comprising writing the received music selection (see., abstract, lines 9-14, col 4, lines 21-31, col 6, lines 22-40, fig 1, Its); transmitting, subsequent to the recording, to the user customer household (see., fig 1, download or record the music, the jukebox of Kleiman is capable of playing and transmitting the recorded music selections); billing the customer household for the at least one transmitted key (see., col 5, lines 16-28, specifically wherein it is stated that "a secure environment for the transfer of music and other sensitive information for purchasing songs or paying (paying or billing) for services from the central storage location to each of the computer jukeboxes (jukeboxes or customer), please note that the secure environment of Kleiman is capable of billing the customer or jukebox for the music selection).

It is noted that Kleiman fails to explicitly disclose that the music selection is in encrypted form to a removable storage medium, such that the music selection can not be decrypted without at least one key. However, Yamanaka, Yasuhiro discloses a TV music broadcasting program that is distributed from a distribution through a ground station and a satellite, and a musical-piece

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program through a plurality of audio channels. A recording medium such as compact disc (CD) or removable storage medium in which the musical-piece is recorded. While recording the musical-piece a key is provided for deciphering at a receiving side for deciphering a musical piece enciphered by scrambling processing and distributed (see., abstract, col 7, lines 26-53, col 11, lines 3-17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the music distribution of Kleiman by including the key enciphering/deciphering taught by Yamanaka, Yasuhiro because such modification would provide the music distribution of Kleiman with the enhanced necessary to download a distributed musical-piece using the proper key.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 43-46 and 86-89 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kleiman and Yamanaka, Yasuhiro in view of Looney et al. (U.S. pat. No. 5,969,283).

**As per claims 43, 44-46 and 86-89 Kleiman and Yasuhiro substantially disclose the claimed limitations as stated in claim 18 above. It is noted that Kleiman and Yasuhiro do not**

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explicitly disclose that an ID tag has been recorded into the recorded music to identify the customer at which the recorded is made.

However, **Looney** discloses a music organizer and entertainment center wherein a CD-ROM and/or individual songs can include a special code or identification that is keyed to the user's system code. In this manner only the user's system can load the songs on its hard drive, see., Looney, col 2, lines 51-54 (which is equivalent to the limitation detailed above wherein said an ID tag or ID in the recorded music to identify the customer at which the recording is made).

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of **Kleiman and Yasuhiro** by including the membership customer ID or ID tag taught by Looney because such modification would provide the music distribution of Kleiman with the advantage of having an individual ID for customers, the customer can have a library of music to playback in a variety of portable and fixed base units (see., Looney, col 2, lines 56-58).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 90-96 are rejected under 35 U.S.C. 102 (e) as being anticipated by Kleiman.

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**As per claims 90-96, Kleiman discloses a TV music broadcasting program that is distributed from a distribution through a ground station and a satellite, and a musical-piece program through a plurality of audio channels. A recording medium such as compact disc (CD) or removable storage medium in which the musical-piece is recorded. While recording the musical-piece a key is provided for deciphering at a receiving side for deciphering a musical piece enciphered by scrambling processing and distributed (which is seen to read as Applicant's claimed invention wherein it is stated that a system for distributing music to a plurality of customer households), the system comprising:**

**a data transmission system blanket transmitting a plurality of music selections to a plurality of user stations, in digital format (this limitation is disclosed by Kleiman in the abstract, lines 5-9, specifically wherein it is stated that "a jukebox (or customer) selectively requests the transmission of songs from the central storage location using a variety of communication means based upon usage data with respect to songs and the menu");**

**a user station at the plurality of customer households, enabling the customer household to preview the plurality of music selections a predetermined number of times before billing the customer households for the plurality of music selections, the user station (see., Kleiman in the abstract, lines 9-14, col 3, lines 13-52, specifically wherein it is stated that the request can be initiated by the jukebox and can occur automatically based on statistics compiled by the jukebox representing user demand (statistics compiled by the jukebox or preview the**

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**music). The central storage location processes the requests and schedules individual requests from each jukebox to coordinate transmission of music to multiple locations simultaneously, and also col 4, lines 21-31, col 6, lines 22-40, fig 1, Its, including:**

a user interface for permitting the customer household to preselected a transmitted music selection for recording and designate music preference information (**this limitation is disclosed by Kleiman in the abstract, lines 9-14, specifically wherein it is stated that “the request can be initiated by the jukebox and can occur automatically based on statistics compiled by the jukebox representing user demand (or preselected music). The central storage location processes the requests and schedules individual requests from each jukebox to coordinate transmission of music to multiple locations simultaneously”, and also col 4, lines 21-31, col 6, lines 22-40, fig 1, Its, interface or modem);**

a receiver and a high capacity storage medium (or download the music), in communication with the receiver, for recording the preselected music selection in digital form (**this limitation is disclosed by Kleiman in the abstract, lines 9-17, specifically wherein it is stated that “the request can be initiated by the jukebox and can occur automatically based on statistics compiled by the jukebox representing user demand. The central storage location processes the requests and schedules individual requests from each jukebox to coordinate transmission of music to multiple locations simultaneously”, and also col 4, lines 21-31, col 6, lines 22-40, fig 1, ITs, please note that this is the process of downloading the music at the jukebox or customer, and high capacity storage medium or central storage location);**

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an audio output for outputting audio signals from the high capacity storage medium to a playback device for enabling the customer household to playback the recorded music selection (this limitation is disclosed by Kleiman in Fig 2A, specifically, wherein it is showed that “Reggae, Blues and so on , please note that it is inherent to recognize that in order for the users to play the music an audio output such as speaker, head phone is needed, col 9, lines 1-20);

a central controller system having a database for storing therein information corresponding to the customer (see., Kleiman in the abstract, lines 2-9, col 4, lines 50-59, specifically, wherein it is stated that “menuing system or music that is stored in a central storage location or database);

a communications link between each customer household and the central controller system for verifying to the controller system when a preselected music selection has been made available for playback (this limitation is disclosed by Kleiman in the abstract, lines 5-17, specifically wherein it is stated that “ a jukebox (or customer) selectively requests the transmission of songs from the central storage location using a variety of communication means based upon usage data with respect to songs and the menu. The central storage location periodically updates the local jukeboxes with a list of new releases, during which time the jukebox can also download (download or record) the music”, please note that the central storage location is readable as a central controller database, since it can coordinate transmission of music to multiple locations simultaneously and update the local jukeboxes, please also note that since the central storage location or central controller periodically updates, processes, and schedules individual requests from each jukebox or customer, during which time the jukebox or customer can

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**download or copy the music, and therefore, can verify when music selection has been recorded or download or copy);**

a billing system associated with the central controller system to bill customer households for music selections that are recorded (**this limitation is disclosed by Kleiman in col 5, lines 16-28, specifically wherein it is stated “a secure environment for the transfer of music and other sensitive information for purchasing songs or paying (paying or billing) for services from the central location to each of the computer jukeboxes (jukeboxes or customer), please note that the secure environment of Kleiman is capable of billing the customer or jukeboxes for the music selection).**

*Allowable Subject Matter*

9. Claims 17, 28, 60 and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**CONCLUSION**

10. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9769.

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**Any response to this action should be mailed to:**

Commissioner of Patents of Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**OR**

(703) 305-9724, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth floor (receptionist).

The Official Fax Number For TC-3600 is:



Pierre Eddy Elisca

Patent Examiner

**October 07, 2002**